

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Ralf Prenzel
Appl. No.: 10/511,056
Conf. No.: 6152
Filed: October 11, 2004
Title: A METHOD FOR TRANSMITTING DATA, PARTICULARLY HAVING
MULTIMEDIA CONTENTS, IN A MOBILE COMMUNICATION NETWORK
Art Unit: 2618
Examiner: Bobbak Safaipoor
Docket No.: 0112740-1015

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

This request is submitted in response to the Office Action dated d October 3, 2007. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review," form PTO/SB/31 and "Notice of Appeal" and Petition for a One (1) Month Extension of Time.

REMARKS

I. The Rejection to Claims 16-25 and 27-30 under 35 U.S.C. §103(a) as being unpatentable over Wireless Application Protocol, MMS Encapsulated Protocol, Version 05-Jan-2002 (hereinafter "WAP") in view of Ratschunas et al. (WO 01/28171 A1), and claim 26 under 35 U.S.C. §103(a) as being unpatentable over WAP in view of Ratschunas et al. (WO 01/28171 A1) and Aho (US Patent Pub. 2001/0010685) are Improper.

1. Applied References

In the Response to Arguments, beginning on page 2 of the Office Action, the Examiner responds to Applicants arguments individually with respect to limitations 1-3 of claim 16 (and claim 27). As an initial matter, Applicants note that the Examiner cites WAP as disclosing the first limitation only, and relies on Ratchunas as disclosing limitations two and three. The focus of Applicants arguments relate primarily to limitations two and three, as stated herein below.

The cited art, either alone or in combination, fails to teach or suggest the features of “providing, upon non-deliverability of the data to the second communications unit, an item of information concerning the non-deliverability of the transmitted data in the transmission status message; and wherein the non-deliverability of the data sent applies if one of the correct receipt of the data sent and a recipient notification message concerning the data to be transmitted to the second communications unit is not acknowledged by the second communications unit via a respectively associated confirmation message” as recited in claim 16, and similarly recited in claim 27. Under the recited configuration, the features address the situation where a MMS message was correctly sent, but not received yet by the receiving device. Typically, under the WAP protocol, information/message regarding the sending of the message is provided for (see “Delivery.ind” and “X.Mms-Status” messages, WAP, section 6.5, page 19 and 7.2.23). The message informs the MMS sender of the status of the message, where the message is created at the network element (M-SR) after receiving acknowledgment from the sender. However, as just explained, the message is not delivered directly from the sender to the receiving unit, but is created at a network element. If the sender of an MMS receives the requested MMS transmission status message relating to a sent message, the sender cannot determine, for example, if the message expired, was not downloaded, or if the receiving unit was not available (see amended specification page 5, lines 1-13).

As has been conceded by the Office, the WAP document does not teach or suggest the aforementioned configuration, and merely describes the status of a message being sent from the sender, discussed above.

Regarding Ratschunas, the document teaches that the transmitter inserts a receiving condition into a message, and the receiver can only receive the message if the receiving condition is met (see Abstract, page 3, lines 6-14). The purpose of this arrangement is to reduce network load by tailoring messages only to recipients that meet a specific condition (e.g., location), where unnecessary messages are not transmitted (page 3, lines 28-34). However, Ratschunas teaches that the “condition” *is one that must be met before the message is even transmitted*. For example, using the location of the device, Ratschunas teaches that the Mobile Location Center (MLC 5) determines the location of the recipient, and if the recipient is not in the intended location, the message is not transmitted (Fig. 2; page 10, line 24 - page 11, line 9).

In the alternate embodiment described on page 12, line 22 - page 13, line 11, the message is transmitted to a multimedia service center (MMSC 2), which then determines whether or not the condition is met.

In either case, Ratschunas does not send out a "transmission status message" where an item of information is provided "concerning the non-deliverability of the transmitted data in the transmission status message; wherein the non-deliverability of the data sent applies if one of [1] the correct receipt of the data sent and [2] a recipient notification message concerning the data to be transmitted to the second communications unit is not acknowledged by the second communications unit via a respectively associated confirmation message." As explained above, Ratschunas only checks the condition of the recipient before any message is sent - the "transmission status" is not observed. Also, the second communication unit cannot transmit back a confirmation message, since the message would not have been sent in the first place.

The Examiner counters this argument by referring to Fig. 2; steps S6-S7; page 12, ln. 31 to page 13, ln. 4 of the reference, stating that the MMSC in Ratschunas accesses the receiving condition information of the multimedia message (step S5) and decides whether the receiving condition is met. If the condition is not met (NO in step S6), a message indicates that the MS is inactive or busy (read as correct receipt of the data sent is not acknowledged by the second communications unit). The message is sent to the originator that the MS is not reachable. Applicants respectfully disagree. As explained above, this passage of the reference refers to the message being transmitted to a multimedia service center MMSC 2, which then determines whether or not the condition (embedded in the message) is met. And, again, the second communication unit is not transmitting a confirmation message, since the message is never sent to begin with.

2. Obviousness

Moreover, there is no apparent reason why one skilled in the art would combine the WAP document and the Ratschunas reference in the manner suggested in the Office Action. Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary consideration (e.g., the problem solved). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ2d 459, 467

(1966). “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006)(“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1389.

Appellant respectfully submits that the Office Action has improperly piecemealed individual features from multiple references to arrive at the present rejection. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 127 S. Ct. at 1732. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning.” *KSR* 127 S. Ct. at 1740.

Regarding WAP, the sending status is already known. For example, in section 7.2.20, the “Response-Status” field is described within the “M-Send.conf” message (see section 6.1.2, page 14). This configuration is acknowledged in FIG. 2 and related text in the present specification (page 13, line 8 - page 14, line 30), which is believed to be consistent with the disclosure in the WAP document. As was explained previously, the “M-Send.req” message provides error and

status information with regard to the sending of the MMS message (see also 7.2.23: “retrieved”, “rejected”, “deferred”, “unrecognized”, “expired.”). Since the WAP document already provides the statuses of the sent messages, there is no reason to modify the reference in the manner suggested, absent hindsight reconstruction that relied on the Applicant’s disclosure. For at least these reasons, Applicant submits the rejection is improper and should be withdrawn.

II. Conclusion

In light of the above, the Applicants submit that all the claims are both novel and non-obvious over the prior art of record. Accordingly, the Applicants respectfully request that a Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Director is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (112740-1015 on the account statement.

Respectfully submitted,

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